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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,415	04/24/2001	Michael P. Straub	Verizon-9	5473

32127 7590 08/11/2005

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EXAMINER

HONG, HARRY S

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/841,415	STRAUB ET AL.	
	Examiner	Art Unit	
	Harry S. Hong	2642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

The indicated allowability of claims 3-7 is withdrawn in view of the newly discovered reference(s) to Kajiya et al. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kajiya et al. (Kajiya; 5,448,626; cited and applied for the first time).

Column 4, line 1 – column 5, line 10 of Kajiya plainly teaches the claimed communications method of claims 1, and 3-5. The stored voice telephone number and the fax telephone number are clearly depicted in FIG. 2.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 2, 7, 19, 20, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kajiya as applied above in view of Freeman (6,020,980; previously cited and applied).

Kajiya is silent with respect to the feature of forwarding the fax calls to an email address. However, Freeman plainly teaches such a feature. Therefore, it would have been obvious even to one of ordinary skill in the art at the time of the invention to modify the method of Kajiya to forward the fax calls to an email address as taught by Freeman in order to provide the subscribers more convenience by delivering the fax right to their computers.

7. Claims 6, 8-11, 21-23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kajiya in view of Furman (5,465,295; previously cited and applied).

Claims 6, 8-11, 21-23, and 25 differ from Kajiya in that the method of Kajiya is implemented in a private network having in-band signaling instead of a public AIN. The claimed peripheral device can read on the TELEPHONE/FAX DISCRIMINATOR of FIG. 6. However, Furman teaches that fax call forwarding methods can be implemented in a public AIN. Therefore, lacking criticality, it would have been obvious even to one of ordinary skill in the art at the time of the invention to implement the concept taught by Kajiya in the public AIN as taught by Furman in order to provide such services to the general public. Terminating Attempt Triggers are inherent to AIN signaling.

8. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kajiya in view of Furman as applied to claims 8-11 above, and further in view of Freeman.

Kajiya in view of Furman is silent with respect to the feature of forwarding the fax calls to an email address. However, Freeman plainly teaches such a feature. Therefore, it would have been obvious even to one of ordinary skill in the art at the time of the invention to modify the method of Kajiya in view of Furman to forward the fax calls to an email address as taught by Freeman in order to provide the subscribers more convenience by delivering the fax right to their computers.

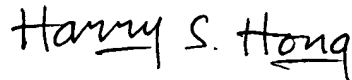
9. Applicant's arguments with respect to claims 1-13 and 19-26 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry S. Hong whose telephone number is (571) 272-4785. The examiner can normally be reached on is normally off on Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on (571) 272-4788. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Harry S. Hong
Primary Examiner
Art Unit 2642

August 8, 2005